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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,855	10/26/2000	Kazumasa Yoshikawa	1232-4655	2813

7590

05/24/2004

Mikchael M Murray
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EXAMINER

YE, LIN

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 05/24/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,855

Applicant(s)

YOSHIKAWA ET AL.

Examiner

Lin Ye

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S. C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-9, 13-16, 19-21, 25-27, 30-31, 33-34, 37-42, 44-45 and 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuchiya et al. U.S. Patent 5,068,735.

Referring to claim 1, the Tuchiys reference discloses in Figures 1-2 and 5, an optical apparatus comprising: an optical member (lens 64a of the TV camera 64, see Col. 3, lines 50-52) constituting the optical apparatus; memory (RAM 30 in the microcomputer, Col. 4, lines 22-23) means for memorizing preset position information and preset speed information (the preset value includes the direction, position and speed values of zooming, focusing, panning and tilting of camera stored in RAM 30, see Col. 2, lines 13-16, 29-38 and Col. 5, lines 16-24); memory instructing operation means (as shown in Figure 2, the control box 63 includes switches 65 to 69) to be operated for causing said memory means to memorized the preset speed information (See Col. 4, lines 20-25); and control means; for executing preset drive control on said optical member; wherein said control means (11 and 14 including zooming, focusing ,panning and tilting control means, see Col. 2, lines 9-20) is adapted to cause said memory means (RAM30) to memorize arbitrary preset speed information in response to the

Art Unit: 2612

operation of said memory instructing operation means, and to drive said optical member to a position corresponding to said memorized preset position information with a speed corresponding to said memorized preset speed information as shown in Figure 1 (See Col. 1, lines 38-43 and Col. 2, lines 39-53, **It should be noted, the examiner understands the applicant specification states the preset position and speed information is only for adjusting zooming optical member. However, the claim does not defined as this way. For this reason, the preset position information and speed information of the optical member can be considered either as the zooming, focusing, panning or tilting motion of camera too).**

Referring to claim 2, the Tuchiys reference discloses wherein: said control means (i.e., the zooming controls 22, see Col. 5, lines 16-24) is adapted, when said optical member is driven (by zooming servo-mechanism 34) and said memory instructing operation means is operated, to cause said memory means to memorize the actual drive speed of said optical member at the time of operation of said memory instructing operation means as the preset speed information (to change value of zooming which including the direction, position and speed values of lens).

Referring to claim 3, the Tuchiys reference discloses drive instructing operation means (e.g. CPU 29 reads from a predetermined address of the RAM 30 indicative to the orientation of the camera 62, see Col. 5, lines 53) to be operated for generating a drive speed command for said optical member corresponding to the operation amount; wherein said control means is adapted, when said drive instructing operation means is operated and said memory instructing operation means is operated, to cause said memory means to memorize the drive

Art Unit: 2612

speed command at the time of operation of said memory instructing operation means as the preset speed information (see Col. 5, lines 54-67).

Referring to claim 4, the Tuchiys reference discloses wherein said control means is adapted, in the execution of said preset drive control, to compare the actual drive speed of said optical member (camera 64) with a drive speed corresponding to the preset speed information and to control to increase or decrease (adjust the a value of zooming, focusing, panning and tilting respect to the reset value of information that including the direction, position and speed values of camera in the RAM 30) the actual drive speed of said optical member in such a manner that said two drive speeds substantially coincide (See Col. 5, lines 16-47).

Referring to claim 7, the Tuchiys reference discloses wherein control starting operation means (as shown in Figure 1, step 14) to be operated for starting said preset drive control (See Figure 3, steps 46-48).

Referring to claim 8, the Tuchiys reference discloses wherein said control means is adapted to interrupt (e.g., set the time interval for changing the preset drive control) said preset drive control in response to the operation of said control starting operation means in the course of said preset drive control as show in Figure 3 (See Col. 5, lines 48-53).

Referring to claim 9, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 1 and 8; and drive instructing operation means to be operated for generating a drive speed command for said optical member according to the operation amount (See Col. 5, lines 65-67).

Referring to claim 13, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 1.

Referring to claim 14, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 2.

Referring to claim 15, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 3.

Referring to claim 16, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 4.

Referring to claim 19, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 7.

Referring to claim 20, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 8.

Referring to claim 21, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 9.

Referring to claim 25, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 1.

Referring to claim 26, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 2.

Referring to claim 27, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 3.

Referring to claim 29, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 1, and the reference discloses the memory (30) for

Art Unit: 2612

memorizing preset speed information and preset direction information (i.e., set rightward panning motion is additive, the leftward p motion is subtractive, see Col. 5, lines 34-42 and Col. 2, lines 14-15).

Referring to claim 30, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 2 and 29.

Referring to claim 31, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 3 and 29.

Referring to claim 33, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 3 and 29 (the preset value includes the **direction**, position and speed values of zooming, focusing, panning and tilting of camera stored in RAM 30, see Col. 2, lines 13-16, 29-38 and Col. 5, lines 16-24).

Referring to claim 34, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 4 and 29.

Referring to claim 37, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 7 and 29.

Referring to claim 38, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 7-8 and 29.

Referring to claim 39, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claims 9 and 29.

Referring to claim 40, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 29.

Referring to claim 41, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 30.

Referring to claim 42, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 31.

Referring to claim 44, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 33.

Referring to claim 45, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 34.

Referring to claim 48, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 37.

Referring to claim 49, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 38.

Referring to claim 50, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 39.

Referring to claim 51, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 29.

Referring to claim 52, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 30.

Referring to claim 53, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim 31.

Art Unit: 2612

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 17, 35 and 46 rejected under 35 U.S. C. 103(a) as being unpatentable over Tuchiya et al. U.S. Patent 5,068,735 in view of Kawamura et al. U.S Patent 4,699,487.

Referring to claim 5, the Tuchiya reference discloses all subject matter as discussed in respected claim 1, except that the reference does not explicitly show a display means for displaying (indicating to user) that said preset drive control is executed.

The Kawamura reference discloses in Figure 13, a camera has a plurality of modes (control operations, see Col. 21, lines 33-46); a display element (3a) of the display means (3) is made to blink, informing that the camera has been switched to the single shooting automatic (preset drive control) speed change mode (See Col. 22, lines 59-63). The Kawamura reference is evidence that one of ordinary skill in the art at the time to see more advantages for the camera apparatus can comprise a display means for indicating which mode (control operation) is executed so that user can be easy to know what control operation of camera in the present, specially for the camera have a plurality of modes for different control operation. For that reason, it would have been obvious to see the camera including a

Art Unit: 2612

display means for displaying (indicating to user) that said preset drive control is executed disclosed by Tuchiya.

Referring to claim 17, the Tuchiys and Kawamura references disclose all subject matter as discussed with respected to same comment as with claim 5.

Referring to claim 35, the Tuchiys and Kawamura references disclose all subject matter as discussed with respected to same comment as with claims 5 and 29.

Referring to claim 46, the Tuchiys reference discloses all subject matter as discussed with respected to same comment as with claim claims 5 and 29.

5. Claims 6, 18, 28, 36, 47 and 54 rejected under 35 U.S. C. 103(a) as being unpatentable over Tuchiya et al. U.S. Patent 5,068,735 in view of Ogawa et al. U.S Patent 5,311,230.

Referring to claim 6, the Tuchiya reference discloses all subject matter as discussed in respected claim 1, except that the reference does not explicitly show a speed selecting operation means to be operated for selecting the drive speed of said optical member either at a drive speed corresponding to the preset speed information or at a maximum drivable speed.

The Ogawa reference discloses in Figures 1-3, a zoom lens camera has a zooming speed input means (8 as shown in Figures 1) for inputting and selecting the drive speed of the zoom lens either at a drive speed corresponding to the preset speed information or at a maximum drivable (highest) speed in Figure 4 which shows a zoom processing (see Col. 3, lines 20-30 and lines 44-51). The Ogawa reference is evidence that one of ordinary skill in the art at the time to see more advantages for the camera apparatus can be to enable the zooming speed to be changed as desired so that increase the degree of freedom with which photographing can

be conducted (See Col. 1, lines 47-51). For that reason, it would have been obvious to see the camera including a speed selecting operation means to be operated for selecting the drive speed of said optical member either at a drive speed corresponding to the preset speed information or at a maximum drivable speed disclosed by Tuchiya.

Referring to claim 18, the Tuchiys and Ogawa references disclose all subject matter as discussed with respected to same comment as with claim 6.

Referring to claim 28, the Tuchiys and Ogawa references disclose all subject matter as discussed with respected to same comment as with claim 6.

Referring to claim 36, the Tuchiys and Ogawa references disclose all subject matter as discussed with respected to same comment as with claims 6 and 29.

Referring to claim 47, the Tuchiys and Ogawa references disclose all subject matter as discussed with respected to same comment as with claims 6 and 29.

Referring to claim 54, the Tuchiys and Ogawa references disclose all subject matter as discussed with respected to same comment as with claims 6 and 29.

6. Claims 10-12, 22-24, 32 and 43 rejected under 35 U.S. C. 103(a) as being unpatentable over Tuchiya et al. U.S. Patent 5,068,735 in view of Okino et al. U.S Patent 5,867,217.

Referring to claims 11-12, the Tuchiya reference discloses all subject matter as discussed in respected claims 1 and 7, and states for shooting the focusing, zooming, panning and tilting motions for each of the scenes can be previously written in the memory; except that the reference does not explicitly show a position detection (zooming value detection) means

for detecting the actual drive position of the optical member in response to the operation of the memory instructing operation means for storing the position data in the memory.

The Okino reference discloses in Figure 1, an optical apparatus comprises an optical member (lens groups 1,2,3, and 4); and a zoom encoder (7, see Col. 4, lines 49-50) for detecting the positions of the second lens group and store the position information to the memory (17, see Col. 4, lines 62-67) in response to the operation of the memory instructing operation means. The Okino reference is evidence that one of ordinary skill in the art at the time to see more advantages for the camera apparatus have a position detection means for detecting the actual drive position of optical member for previously desired scenes and save these information to memory so that controlling camera operation can be operated extremely easily by using those information from memory. For that reason, it would have been obvious to see the camera including a position detection (zooming value detection) means for detecting the actual drive position of the optical member in response to the operation of the memory instructing operation means for storing the position data in the memory disclosed by Tuchiya.

Referring to claims 22-24, the Tuchiys and Okino references disclose all subject matter as discussed with respected to same comment as with claims 10-12.

Referring to claim 32, the Tuchiys and Okino references disclose all subject matter as discussed with respected to same comment as with claims 10-12 and 29.

Referring to claim 43, the Tuchiys and Okino references disclose all subject matter as discussed with respected to same comment as with claims 10-12 and 29.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 13, 25, 29, 40 and 51 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,704,503.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Relative to **claim 1 of U.S. Patent No. 6,704,503** is a broader recitation of the same invention claimed in this application (09/696855) claims 1, 13, 25, 29, 40 and 51. Therefore, claim 1 of U.S. Patent No. 6,704,503 encompassed by the application (09/696855) claims 1, 13, 25, 29, 40 and 51 (e.g., "preset information" can be considered as preset position information, preset speed information or preset direction information). It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

Conclusion

Art Unit: 2612

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Ye whose telephone number is (703) 305-3250. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R Garber can be reached on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to:

(703) 872-9306

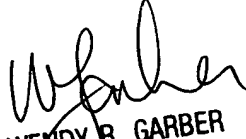
Hand-delivered responses should be brought to Crystal Park 11, 2121 Crystal drive,

Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Lin Ye

May 13, 2004


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600